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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,197	12/08/2004	Jakob P. Ley	47940	7605

1609 7590 04/21/2006

ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.  
1300 19TH STREET, N.W.  
SUITE 600  
WASHINGTON,, DC 20036

EXAMINER

KUMAR, SHAILENDRA

ART UNIT PAPER NUMBER

1621

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/517,197

Applicant(s)

LEY ET AL.

Examiner

SHAILENDRA -. KUMAR

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to applicants' communication filed on 2/14/06.

Claims 1-14 and 16-23 are pending in this application.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 and 16-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 proviso outs compounds in which X represents O, R1 is pentyl, R3 and R2 are hydrogen and R4 is methyl. It is not clear as to if R2 is not hydrogen then what is R2. Note that there is no other definition for R2 in claim 1.

3. Claims 2, 13, recites the limitation "octylacetamide when R3 and R4 are OH and methoxy" in lines 8 and 11. There is insufficient antecedent basis for this limitation in the claim.

Note, applicants have made an exception to these compounds in preceding claims.

#### ***Claim Rejections - 35 USC § 102***

4. Claims 1-6 and 12-13, 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al (FEBS Letters, Vol 269, number 2, pages 381-385, 1990).

Wood et al, page 383, Table 1, compound F anticipates instant claimed compounds, composition and method. Also see, page 381, in the introduction section, line 2, wherein it is expressly taught that the compounds have pungent character.

***Claim Rejections - 35 USC § 103***

5. Claims 1-13 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined teachings of Wood et al and WO'258.

Wood et al teach structurally similar compounds, composition and method of use as claimed herein. See for example, compound F in Table 1, on page 383. The difference between the reference and herein claimed composition is that the reference is not mentioning foodstuff composition or cosmetic composition or pharmaceutical composition.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to obtain compounds having lower homolog or higher homolog of the F compound of the reference, because homologs are obvious over each other, or alternatively prepare food or cosmetic composition as taught by WO'258, because the latter reference is expressly teaching that structurally similar compounds can be used for such composition, with the reasonable expectation of achieving a successful composition, absent evidence to the contrary. In re Hass, 141 F.2d 127, 60 USPQ 548 (CCPA 1944). Also note that combination of two compositions are old in the art. In re Kerkoven, 205 USPQ 1069 (CCPA 1980).

6. Claim 14 is again rejected under 35 U.S.C. 103(a) as being unpatentable over WO'258, all for the reasons of record.

As explained in the previous action, WO'258 is teaching analogous process of preparing structurally similar compounds as claimed herein. See page 8, last line.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was used to start with starting material which are similar to those claimed herein, with the reasonable expectation of achieving a product which is similar to herein, because the process is analogous, the product is structurally similar, absent evidence to the contrary.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SHAIENDRA - KUMAR  
Primary Examiner  
Art Unit 1621

S.Kumar  
4/18/06